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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,258	01/31/2002	Magnus Ljungstrom	HO-P02314US1	2268
26271	7590	06/15/2005	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			SNAY, JEFFREY R	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/062,258

**Applicant(s)**

LJUNGSTROM ET AL.

**Examiner**

Jeffrey R. Snay

**Art Unit**

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/10/02, 12/10/03</u>   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-13 in the reply filed on 03/18/2005 is acknowledged.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 3-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the presence of either means I or means II, but in paragraph (e) further recites the presence of a controller that controls means I and means II. The inconsistency makes it impossible to determine whether the claim encompasses one or both of the recited means.

Claim 13 is indefinite in that it recites a limitation which is dependent upon some process condition, particularly, "during flow conditions." However, the claims provide no description by which the recited flow conditions are defined or even referenced. Thus, it is unclear under what conditions the claim requires the substance to be immobilized.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon ('577).

Gordon discloses an optical analysis apparatus which clearly includes all of the presently recited elements. Referring to Figure 6, Gordon teaches the device including a rotatable disc holder (44), which is formed of plastic (column 5, line 1), a detector head (46), and a controller (49) for controlling positioning and operation of both the rotating disc and the detector head. The disc is rotated via a spindle motor (47) and the detector head is moved step-wise via a stepper motor (48) (see column 8, last paragraph). The device of Gordon further includes an angular aligning system in the form of black bar (50) and a radial aligning system in the form of the disc edge (see column 9, first and second paragraphs). In operation, the black bar is sensed by the detector head to indicate a calibrated home angular position and the disc edge is sensed to indicate a calibrated home radial position. Subsequently, the controller and computer elements are capable of tracking relative movements of the detector head and disc such that precise determination of the position of the light source/detector arrangement relative to the disc is enabled (column 9, lines 21-24). In a similar but alternative embodiment, such positioning with respect to the surface of the disc, and consequently the samples located thereon, is provided by integrating digital encoding

structures on the disc which are detected and interpreted by the detector (column 6, lines 20-32).

Regarding instant claim 3, Gordon discloses the use of laser light source (8) and acknowledges the application to measuring fluorescence (column 1, 3d paragraph). Regarding instant claim 4, see Gordon at column 8, 3d full paragraph). Regarding instant claims 5 and 6, it is noted that the relative coverage of the detection area would be entirely dependant on one's definition of the detection area. Thus, Gordon teaches coverage of at least one detection area defined as a single sample, and also teaches coverage of only a part of the detection area defined as the whole disc. Regarding instant claim 12, Gordon teaches the calibration mark (50) as being black. It is noted that instant claim 12 does not preclude the presence of other materials which are not black. Regarding instant claim 13, Gordon teaches that detection agents are immobilized at different locations of the disc, including electrophoretic gels. Since the claim fails to define any particular flow conditions, and the substances in Gordon are immobilized throughout the operation of the device, it must be concluded that the limitation of instant claim 13 is fully satisfied by the Gordon device.

***Priority***

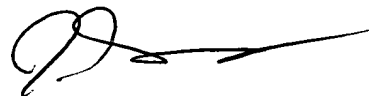
6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (571) 272-1264. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey R. Snay  
Primary Examiner  
Art Unit 1743

jrs